

REMARKS

This is in response to the Office Action mailed on July 7, 2005, in which pending claims 15-30 were considered, claims 15-17 and 19-30 were rejected, and claim 18 was objected to.

Independent claim 15

Independent claim 15 recites a tape roll that includes a central tape roll axis and a length of tape circumferentially wound about the axis, the tape having first and second sides. The second side (which faces inward, toward the axis) is at least partially covered with pressure sensitive adhesive. The tape roll also includes a tab having first and second sides. At least a portion of the second side of the tab is covered with pressure sensitive adhesive. The adhesive portion of the second side of the tab is adhered to the first side of the tape on a penultimate layer of the roll, so that the trailing end of the tape overlays the tab between first and second ends of the tab.

The Examiner rejected independent claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Dills (USP 4,512,462) in view of Hammond (USP 2,015,268). The Examiner contended that Dills discloses all of the elements of the claim except that the tab has an adhesive section on its second side which is adhered to the first side of the tape. The Examiner turned to the teachings of Hammond to supply this deficiency, contending that "Hammond shows that providing adhesive on a tab with [a] hole or without [a] hole, including adhesive and non-adhesive portions, are equivalent structure[s] known in the art. Therefore, because these two adhesive tabs with holes and ... without holes were art recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute Hammond's adhesive tab without holes for Dills' tab with at least one hole."

Dills discloses a tape roll (22) having a removable, reusable tab (10) with an opening (18). A portion of the tape (20) projects through the opening (18) of the tape roll (22) and is readhered to the roll. See FIGS. 2 and 3 and the description at column 2, lines 49-66. The tab (10) does not have adhesive on either of its sides, but instead relies on the adhesive of the tape (20) that projects through the opening (18) to adhere the tape (20) and tab (18) together to the tape roll (22).

Hammond discloses a tape roll having a tab strip (c) having adhesive on one side so that it is adhered to the tape roll coil (e). The tab strip (c) also has a plurality of holes punched in it, to reduce the level of adhesion between the tape (b) and the tab strip (c). See FIG. 1 and the description on the right-hand column of page 1, lines 20-53. The tape (b) overlays all of the tab strip (c), so that no portion of the tab strip (c) is exposed. This configuration is shown in FIG. 1 of the instant application, described as "overtabbing" which is known in the art (and the problems of which are described in the background portion of the instant application).

The Examiner has proposed a combination of Dills and Hammond, contending that this combination renders obvious the subject matter recited by independent claim 15. In order to reject a claim as being obvious over a combination of references, three basic requirements must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. See M.P.E.P. 2143.

In this case, there is no teaching or suggestion to combine the references cited by the Examiner in the manner recited by claim 15; the only motivation to combine these references is provided by the Applicant's disclosure. The Examiner proposes modifying the tab (10) of Dills to include an adhesive portion for securing the tab to the tape roll (22), along the lines taught by Hammond. However, this modification would render useless the opening (18) in the tab (10) that is taught by Dills to be provided explicitly for the purpose of sticking the tab (10) to the roll (22). See column 3, lines 7-10. Because Dills already teaches a structure designed to provide adherence to the tape roll (via the tape projecting through an opening), one skilled in the art would have no motivation to modify the teachings of Dill to provide adhesive on the tab itself for adherence to the tape roll.

This argument was previously presented in the Amendment filed on October 21, 2004, which resulted in the Examiner's rejection of claim 15 as being unpatentable over Dills in view of Hammond being withdrawn "for reasons of record in the amendment filed on October 21, 2004." The only different proposition that the Examiner has made in the current rejection of claim 15 as being unpatentable over Dills in view of Hammond is that "providing adhesive on a tab with [a] hole or without [a] hole, including adhesive and non-adhesive portions, are equivalent structure known in the art."

The Examiner's contention of art-known equivalency is misapplied to the rejection of claim 15. In order to reject claim 15, the Examiner has combined all of the teachings of Dills with one particular teaching of Hammond (a tab having adhesive and non-adhesive portions), but no other teaching of Hammond (such as the overtabbing configuration in which no portion of the tab is left exposed). The Examiner is not suggesting to substitute the tab of Hammond for the tab of Dills, because such a substitution would not disclose all of the elements of claim 15. Instead, the Examiner seeks to only substitute the teaching of Hammond that the tab has an adhesive portion for the teaching of Dills that the tab has no adhesive. However, as discussed above, one skilled in the art would have no motivation to substitute this particular teaching from Hammond for the teaching of Dills, as the Dills tab is configured to include a hole through which the adhesive side of the tape causes the tape to adhere to the roll. Because the requisite suggestion or motivation to combine the teachings of Dills and Hammond in the manner recited in claim 15 is lacking, the combination of these references is not proper, and the rejection of claim 15 under 35 U.S.C. § 103(a) should accordingly be withdrawn.

Further evidence that a proposed combination of references would not have been obvious to one of ordinary skill in the art is found in the teachings of Dills, which specifically notes the difficulties associated with markers/tabs for marking the end of a tape that adhere to the tape (such a marker "destroys that portion (of the tape) to which it is adhered"). See column 1, lines 22-29. It is improper to combine references where the references teach away from their combination. M.P.E.P. 2145(X)(D)(2), citing In re Grasselli, 218 U.S.P.Q. (BNA) 769, 779 (Fed. Cir. 1983). In this case, the proposed combination of

Dills and Hammond would require a skilled artisan to modify the tab disclosed by Dills to include adhesive as disclosed by Hammond, in spite of the fact that the Dills patent specifically discloses a tab without adhesive and notes the problems associated with tabs in the prior art that were adhered to the tape. In view of the contrary teachings of Dills, it would not have been obvious to modify the Dills tab to include adhesive as taught by Hammond, and the rejection of claim 15 under 35 U.S.C. § 103(a) should accordingly be withdrawn.

Dependent claims 16, 17 and 20

The Examiner also rejected dependent claims 16, 17 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Dills in view of Hammond. Dependent claim 16, as amended, recites that the second side of the tab comprises a non-adhesive portion having first and second ends, the first end of the non-adhesive portion coinciding with the first end of the tab. The adhesive portion of the second side of the tab has first and second ends, the first end of the adhesive portion being located adjacent to the second end of the non-adhesive portion, and the second end of the adhesive portion coinciding with the second end of the tab. An example of this configuration is shown in FIG. 3a of the instant application. The Examiner pointed to the adhesive portions (g) and the adhesive deadened portions (f) shown in Fig. 2 of Hammond as disclosing the elements of claim 16. However, amended claim 16 is not disclosed by the combination of Dills and Hammond, as Dills teaches no adhesive on the tab and Hammond teaches adhesive portions (g) and non-adhesive portions (f) that are interspersed with one another, and do not satisfy the spatial recitations of amended claim 16. Because the combination of Dills and Hammond fails to disclose all of the elements of amended claim 16 (and also because claim 16 depends from allowable independent claim 15), the rejection of claim 16 under 35 U.S.C. § 103(a) should be withdrawn.

Claims 17 and 20 depend from amended claim 16, and are allowable therewith.

Dependent claims 21-25 and 27-30

The Examiner also rejected dependent claims 21-25 and 27-30 under 35 U.S.C. § 103(a) as being unpatentable over Dills in view of Hammond. Claims 21-25 and 27-30 depend from independent

claim 15, and are allowable therewith. In addition, it is respectfully submitted that the combinations of features recited in claims 21-25 and 27-30 are patentable on their own merits, although this does not need to be specifically addressed herein since any claim depending from a patentable independent claim is also patentable. See M.P.E.P. 2143.03, citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

Dependent claims 19 and 26

Claims 19 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dills in view of Hammond and Golub (USP 2,329,527). Claims 19 and 26 depend from independent claim 15, and are allowable therewith. In addition, it is respectfully submitted that the combinations of features recited in claims 21-25 and 27-30 are patentable on their own merits, although this does not need to be specifically addressed herein since any claim depending from a patentable independent claim is also patentable. See M.P.E.P. 2143.03, citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

Dependent claim 18

The Examiner's indication that dependent claim 18 would be allowable if rewritten in independent form is gratefully acknowledged. Claim 18 is allowable with the base claim from which it depends.

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Application No.: 10/664,429

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CONCLUSION

In view of the foregoing, all pending claims 15-30 are in condition for allowance. A notice to that effect is respectfully requested. The Examiner is cordially invited to contact the undersigned at the telephone number listed below if such a call would in any way facilitate the allowance of this application.

Respectfully submitted,

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Date: 10/7/05

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